

Request for Reconsideration after Final Action

The table below presents the data as entered.

| Input Field | Entered |
|---|--|
| SERIAL NUMBER | 86651773 |
| LAW OFFICE ASSIGNED | LAW OFFICE 112 |
| MARK SECTION | |
| MARK | https://tmng-al.uspto.gov/resting2/api/img/86651773/large |
| LITERAL ELEMENT | LIQUIDMETAL |
| STANDARD CHARACTERS | YES |
| USPTO-GENERATED IMAGE | YES |
| MARK STATEMENT | The mark consists of standard characters, without claim to any particular font style, size or color. |
| ARGUMENT(S) | |
| The Applicant submits the attached Consent Agreement, signed by AERO ADVANCED PAINT TECHNOLOGY, INC., the registered owner of the cited U.S. Reg. No. 4867416 for AERO Liquid Metal, and which has been countersigned by the Applicant. The Applicant will amend the identification of goods in this response per the terms of the Consent Agreement. Accordingly, it is respectfully submitted that the refusal on the grounds of likelihood of confusion with the cited registration should be withdrawn and the application should be allowed to proceed to publication. Should the Examining Attorney not find the forgoing persuasive, Applicant will also file an Appeal to the Trademark Trial and Appeal Board. | |
| EVIDENCE SECTION | |
| EVIDENCE FILE NAME(S) | |
| ORIGINAL PDF FILE | evi_21622320150-20170210155720421521_. LIQUIDMETAL Signed agrmt.pdf |
| CONVERTED PDF FILE(S) (3 pages) | \\TICRS\EXPORT17\IMAGEOUT17\866\517\86651773\xml4\RFR0002.JPG |
| | \\TICRS\EXPORT17\IMAGEOUT17\866\517\86651773\xml4\RFR0003.JPG |
| | \\TICRS\EXPORT17\IMAGEOUT17\866\517\86651773\xml4\RFR0004.JPG |
| DESCRIPTION OF EVIDENCE FILE | Signed Consent Agreement |
| GOODS AND/OR SERVICES SECTION (current) | |
| INTERNATIONAL CLASS | 002 |
| DESCRIPTION | |
| Coating compositions in the nature of paint for application to vehicles | |
| FILING BASIS | Section 1(a) |
| FIRST USE ANYWHERE DATE | At least as early as 04/00/2007 |
| FIRST USE IN COMMERCE DATE | At least as early as 04/00/2007 |
| GOODS AND/OR SERVICES SECTION (proposed) | |
| INTERNATIONAL CLASS | 002 |
| TRACKED TEXT DESCRIPTION | |

~~Coating compositions in the nature of paint for application to vehicles;~~ [Liquid coating compositions in the nature of paint for application by sprayer or paint brush exclusively to refinish vehicles in the automotive aftermarket](#)

FINAL DESCRIPTION

Liquid coating compositions in the nature of paint for application by sprayer or paint brush exclusively to refinish vehicles in the automotive aftermarket

FILING BASIS

Section 1(a)

FIRST USE ANYWHERE DATE

At least as early as 04/00/2007

FIRST USE IN COMMERCE DATE

At least as early as 04/00/2007

SIGNATURE SECTION

RESPONSE SIGNATURE

/dp/

SIGNATORY'S NAME

Dennis Prah

SIGNATORY'S POSITION

Attorney of Record, NY bar member

SIGNATORY'S PHONE NUMBER

2127081800

DATE SIGNED

02/10/2017

AUTHORIZED SIGNATORY

YES

CONCURRENT APPEAL NOTICE FILED

YES

FILING INFORMATION SECTION

SUBMIT DATE

Fri Feb 10 16:22:11 EST 2017

TEAS STAMP

USPTO/RFR-XXX.XXX.XXX.XX-
20170210162211095639-8665
1773-580a9ca34f34e39f4c7a
802d4f96996fee2fd1f613a97
61b83376d40acc21627-N/A-N
/A-20170210155720421521

Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO Form 1960 (Rev 10/2011)

OMB No. 0651-0050 (Exp 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **86651773** LIQUIDMETAL(Standard Characters, see <https://tmng-al.uspto.gov/resting2/api/img/86651773/large>) has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The Applicant submits the attached Consent Agreement, signed by AERO ADVANCED PAINT TECHNOLOGY, INC., the registered owner of the cited U.S. Reg. No. 4867416 for AERO Liquid Metal, and which has been countersigned by the Applicant. The Applicant will amend the identification of goods in this response per the terms of the Consent Agreement. Accordingly, it is respectfully submitted that the refusal on the grounds of likelihood of confusion with the cited registration should be withdrawn and the application should be allowed to proceed to publication. Should the Examining Attorney not find the forgoing persuasive, Applicant will also file an Appeal to the Trademark Trial and Appeal Board.

EVIDENCE

Evidence in the nature of Signed Consent Agreement has been attached.

Original PDF file:

[evi_21622320150-20170210155720421521 . LIQUIDMETAL Signed agrmt.pdf](#)

Converted PDF file(s) (3 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 002 for Coating compositions in the nature of paint for application to vehicles

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 04/00/2007 and first used in commerce at least as early as 04/00/2007 , and is now in use in such commerce.

Proposed:

Tracked Text Description: ~~Coating compositions in the nature of paint for application to vehicles;~~ [Liquid coating compositions in the nature of paint for application by sprayer or paint brush exclusively to refinish vehicles in the automotive aftermarket](#)

Class 002 for Liquid coating compositions in the nature of paint for application by sprayer or paint brush exclusively to refinish vehicles in the automotive aftermarket

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 04/00/2007 and first used in commerce at least as early as 04/00/2007 , and is now in use in such commerce.

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /dp/ Date: 02/10/2017

Signatory's Name: Dennis Prah

Signatory's Position: Attorney of Record, NY bar member

Signatory's Phone Number: 2127081800

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 86651773

Internet Transmission Date: Fri Feb 10 16:22:11 EST 2017

TEAS Stamp: USPTO/RFR-XXX.XXX.XXX.XX-201702101622110

95639-86651773-580a9ca34f34e39f4c7a802d4

f96996fee2fd1f613a9761b83376d40acc21627-

N/A-N/A-20170210155720421521

Consent and Coexistence Agreement

This Consent and Coexistence Agreement ("Agreement") is made by and between PPG Industries Ohio, Inc. ("PPG"), a corporation organized under the laws of Delaware with an address at 3800 West 143rd Street, Cleveland, OH 44111, and Aero Advanced Paint Technology, Inc., ("AERO"), a corporation organized under the laws of Delaware with an office at 1245 Kinnear Road, Columbus, OH 43212. The parties hereto, PPG and AERO, agree as follows:

A. **Background.** AERO owns U.S. Trademark Registration No. 4,867,416 for the mark "AERO Liquid Metal" in connection with "paint in film form for industrial and commercial use" in International Class 002 ("AERO's Registration"). PPG has filed U.S. Trademark Application Serial No. 86/651,773 for the mark "LIQUIDMETAL" in connection with "Coating compositions in the nature of paint for application to vehicles" in International Class 002 ("PPG's Application"). In a Final Office Action issued on September 29, 2016 ("Final Office Action"), PPG's Application was finally refused registration under § 2(d) of the Trademark Act based on AERO's Registration.

2. **Agreement.** The parties believe that no confusion will result from usage of their respective marks in accordance with the agreed-upon usage restrictions set forth herein as well as in view of the differences noted herein.

A. **Differences**

The parties agree that there are differences between each party's marks and their respective goods, including the following:

Marks: AERO's "AERO Liquid Metal" mark is differentiated from PPG's "LIQUIDMETAL" mark because of the additional "AERO" element in AERO's "AERO Liquid Metal" mark and the fact that AERO's mark consists of three separately spaced words, whereas PPG's mark consists of two words that are compound and, thus, not separately spaced.

Goods: AERO's goods are paint in film form, while PPG's goods are liquid coating compositions in the nature of paint for application by sprayer or paint brush exclusively to refinish vehicles in the automotive aftermarket.

B. Amendment

Having carefully considered the foregoing in view of the Final Office Action, PPG agrees to file an amendment in PPG's Application or any applications based thereupon in order to describe the goods associated with the "LIQUIDMETAL" mark as follows:

"Liquid coating~~Coating~~ compositions in the nature of paint for application by sprayer or paint brush exclusively to refinish vehicles in the automotive aftermarket."

("Amendment") Matter to be added in the Amendment is underlined and matter to be deleted is shown in strikethrough format.

C. Usage Restrictions

Considering the foregoing in view of the Final Office Action, PPG agrees to always and only use the "LIQUIDMETAL" mark in connection with liquid coating compositions in the nature of paint for application by sprayer or paint brush exclusively to refinish vehicles in the automotive aftermarket. PPG also agrees to ensure that its officers, agents, servants, parents, subsidiaries, other affiliates, successors, assignees and any and all entities controlled by PPG always and only use the "LIQUIDMETAL" mark in this same manner.

D. AERO's Registration and Mark

PPG acknowledges the validity of AERO's Registration and AERO's right to use the "AERO Liquid Metal" mark. As such, PPG agrees to never object to use or registration of, or otherwise challenge, directly or indirectly, the "AERO Liquid Metal" mark and AERO's Registration.

E. Consent to Registration

Subject to the foregoing, AERO consents to registration of PPG's Application.


AERO and PPG each agrees to work together to address and avoid any possible future confusion based on PPG's usage of the "LIQUIDMETAL" mark. In the unlikely event that either AERO or PPG becomes aware of any actual or even potential confusion, it will contact the other party in an attempt to reach an agreement on steps to eliminate or avoid such confusion.

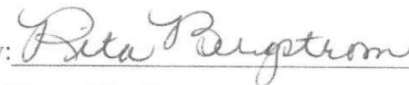
This Agreement is binding on and will inure to the benefit of the parties and their respective officers, agents, servants, parents, subsidiaries, other affiliates, successors, assignees and any and all entities controlled by any party.

Failure of any party at any time to demand strict performance by the other of any term or condition of this Agreement shall not be construed as a continuing waiver or relinquishment thereof, and either party may at any time demand strict and complete performance by the other of said term or condition.

If any term or provision of this Agreement is held invalid or unenforceable by a court or other tribunal of competent jurisdiction, such ruling shall not affect the validity or operation of the remainder of this Agreement, and such term or provision shall be modified to the extent necessary to make it valid and/or enforceable, or, if such modification is not possible, severed from this Agreement.

The parties hereto have caused this Agreement to be executed by their duly authorized representatives below:

By: , an authorized representative
Name: James E. McGuire, Jr.
Title: President, Aero Advanced Paint Technology, Inc.

By: , an authorized representative
Name: Rita Bergstrom
Title: Assistant Secretary, PPG Industries Ohio, Inc.

Date: October 19, 2016